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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,153	11/13/2003	Dewayne M. Turner	020569-05006	8200
22904	7590	09/28/2005	EXAMINER	
LOCKE LIDDELL & SAPP LLP 600 TRAVIS 3400 CHASE TOWER HOUSTON, TX 77002-3095			GAY, JENNIFER HAWKINS	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,153

Applicant(s)

TURNER ET AL.

Examiner

Jennifer H. Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 and 41 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16,19-39 and 42-46 is/are rejected.
- 7) ☒ Claim(s) 3,17 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

A

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement filed 28 April 2003 has been considered in part with only US Patent No(s). 6,220,357; 5,456,322; 6,227,298 being considered. The remaining references and pages of the IDS were not considered to be proper as they are merely photocopies of the Information Disclosure Statements filed by applicant in the parent cases, US Application No(s). 09/378,384 and 10/004,956, as well as the Notices of References Cited sent to applicant for the above applications. While the references cited in a parent application should be cited in the child application, new Information Disclosure Statements must be filed. The examiner notes that she has cited all of the references listed on the IDS filed 28 April 2003 thus no action by applicant is required.

Drawings

2. The drawings are objected to because reference character "46" in Figure 6(c) should be deleted and because Figures 12A-16A, 12B, 14B-16B, 15C, 16C, 12D, 14D-16D, and 13E do not contain reference numbers which the examiner considers essential to the understanding of the claimed invention. Applicant is reminded that any reference numbers added to the above figures should be within or added to the specification.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: 68, 311, 322, and 710.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 169.

5. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended.

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The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The abstract of the disclosure is objected to because the abstract includes the implied phrases "The invention includes in one embodiment" and "The present invention also includes in one embodiment". Correction is required. See MPEP § 608.01(b).

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The disclosure is objected to because of the following informalities: paragraph [0002] should be updated to include the status of all parent applications.

Appropriate correction is required.

Claim Objections

9. Claims 2 and 4 are objected to because of the following informalities: "an object" should be changed to --the object--.. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 4-6, 10-16, 19-22, 24-39, and 42-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Bixenman et al. (US 6,575,246).

Regarding claims 1, 15, 31, 32, 35, 39, 42, 43, 45: Bixenman et al. discloses a valve system in a well that comprises an isolation string that includes the following features:

- An upper packer 7.
- An isolation pipe 143 with pressure activated, double-sub valve 56 and an object activated valve 154.
- An object holding service tool 14 coupled to the objected activated valve and adapted to release an object 103 to engage the object activated valve.

Regarding claims 2, 15, 16, 33, 36-38: The object holding service tool includes a holding barrel 108 having a bore in which the object is slidably and sealingly engaged. The tool is adapted to slidably release the object with sufficient pressure applied to the object to cause a restraining device holding the object to release the object (5:54-62)

Regarding claims 4, 19, 31, 46: The object activated valve includes the following features:

- A tube 143 having at least one opening 158.

- A sleeve (Figure 3C) having at least one other opening and being movably connected to said tube, wherein the at least one opening and the at least one other opening are adjacent in an open configuration and nonadjacent in a closed configuration (Figure 7C).
- An object seat **156** in mechanical communication with said sleeve, wherein said seat receives an object **103** for manipulating the valve between the open and closed configurations.

Regarding claims 5, 34, 44, 47: The object activated valve includes a piston **148** coupled to the sleeve.

Regarding claims 7, 21: The string and valves of Bixenman et al. are disclosed as being part of a gravel packing assembly and method thus would inherently include a production screen where the fluid that passed through the screen would either pass through the above valves prior to passing through the screen or after passing through the screen.

Regarding claims 10, 11, 24, 25: Bixenman et al. discloses a method for isolating a production zone that using the above apparatus. The method involves the following steps:

- Running in the well on the service tool **14**, the isolation string including both valves .
- Setting the string adjacent perforations in the casing.
- Pressurizing the area of the object to releasing the object from the tool.
- Contacting the object activated valve with the object to close the valve.
- Withdrawing the tool from the zone.

Regarding claims 12, 26, 27: The method further involves setting the packer and stinging the isolation string into another isolation string.

Regarding claims 13, 29: The method further involves stinging a production string into the isolation string and opening the pressure activated valve.

Regarding claims 14, 30: The method further involves assisting inclosing the object activated valve by pressurizing an area of the piston.

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Regarding claims 20, 21: The isolation pipe and production pipe are connectable to another isolation string (5:39-44).

Regarding claim 28: The method further involves reconfiguring the object activated valve from an open to a closed configuration with the object

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman et al. in view of Wolff et al. (Us 3,741,300).

Bixenman et al. discloses all of the limitations of the above claims except for the screen being wrapped around the outside of the pressure and object-activated valves.

Wolff et al. discloses a wellbore valve **32**. Wolff et al. further teaches a wrapped screen **34** surrounding the valve (Figure 2).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Bixenman et al. such that the screen was wrapped around the outside of the pressure and object-activated valves as taught by Wolff et al. in order to have filtered fluid entering the system and passing through the valves. Without filtering the formation fluid, sand and other debris would have tended to erode the valves leading to premature failure. Further, placing the screen directly around the valves would have reduced the length of the overall tool thus reducing the time to run the tool into the wellbore.

14. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bixenman et al. in view of Patel (US 6,302,216).

Bixenman et al. discloses all of the limitations of the above claims except for a lower packer in mechanical communication with the isolation pipe.

Patel discloses a system similar to that of Bixenman et al. Patel further teaches an isolation pipe **54** that is in mechanical communication with an upper **18** and a lower **36** packer.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the isolation string of Bixenman et al. to include a lower packer in mechanical communication with the isolation pipe as taught by Patel in order to have provided a means for isolating a single zone and/or preventing commingling of fluids from different zones.

Allowable Subject Matter

15. Claims 40 and 41 are allowed.
16. Claims 3, 17, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

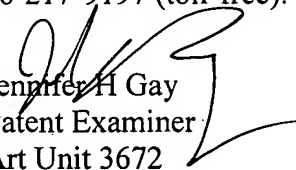
Conclusion

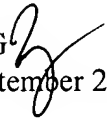
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer H. Gay
Patent Examiner
Art Unit 3672

JHG 
September 26, 2005